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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,099	06/09/2000	Michael J. Cannata	3251141-0002	1745
20988	7590	12/03/2003	EXAMINER	
OGILVY RENAULT 1981 MCGILL COLLEGE AVENUE SUITE 1600 MONTREAL; QC H3A2Y3 CANADA			TODD, GREGORY G	
			ART UNIT	PAPER NUMBER
			2157	

DATE MAILED: 12/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/590,099

Applicant(s)

CANNATA ET AL.

Examiner

Gregory G Todd

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This is a second office action in response to applicant's amendment filed, 15 September 2003, of application filed, with the above serial number, on 09 June 2000 in which claims 1-2, 7, 17, and 19 have been amended, claims 21-66 have been added and claim 3 has been cancelled. Claims 1,2 and 4-66 are therefore pending in the application.

It is noted that claim 13 is declared as being amended, however, the changes to the claim are not highlighted.

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-20 are drawn to a system and corresponding method, computer and data carrier for creating a dedicated site for collaborative computing, classified in class 709, subclass 204.

II. Claims 21-66 are drawn to a system, method, and data carrier having thereon a computer program for providing an access-controlled collaborative workspace, classified in class 709, subclass 229.

2. Newly submitted claims 21-66 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Inventions I-II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, inventions I-II have separate utility such as creating a dedicated workspace for collaborative computing among participants, and

workspace-creator controlling access to particular participants of a created workspace. See MPEP § 806.05(d).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-66 are withdrawn from consideration as being directed to a non-elected invention. See 37 CAR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 4-10, and 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Jiang (hereinafter "Jiang", 6,167,432).

5. As per Claim 1, Jiang discloses a system for providing a collaborative workspace for sharing data, wherein Jiang discloses:

(i) a network-connected server capable of receiving an initiate instruction from a primary user, said server for maintaining a hierarchy between said primary user (e.g. chairperson) and at least one secondary user (at least Fig. 3, 5; col. 5, lines 3-12);

(ii) a site builder for creating a dedicated site on said server in response to said initiate instruction, said dedicated site defining said collaborative workspace (setting up conference web site) (at least col. 2, lines 19-28);

(iii) a transmitter for sending information about the existence of said dedicated site to said at least one secondary user nominated by said primary user (transmit IP address) (at least col. 2, lines 28-38);

(iv) a communicator for transmitting data a) between said dedicated site and, said primary user and b) between said dedicated site and said at least one secondary user, said data being shared in accordance with said hierarchy between said users via said dedicated site (interconnected network with host hosting communication between participants) (at least col. 2, lines 19-33; col. 5, lines 3-26);

(v) memory for storing data associated with said dedicated site, said data from said primary and said at least one secondary user (at least col. 5, lines 3-16; col. 6, lines 51-52);

(vi) a processor for processing said stored data, said processed data being transmitted by said communicator to said primary user and said at least one secondary user (e.g. MIME type stream) (at least col. 5, lines 12-22).

6. As per Claim 2.

wherein said processed data is stored by said primary user and said at least one secondary user (stored in browser to launch an app) (at least col. 5, lines 19-26).

7. As per Claims 4 and 18.

wherein said primary and said at least one secondary users communicate via a web-browser (at least col. 4, lines 6-18).

8. As per Claim 5.

wherein said server contains an address database of communication addresses for said at least one secondary user connected to said network (IP addresses) (at least col. 3, lines 48-64).

9. As per Claim 6.

wherein said network includes an internet connection (at least col. 4, lines 6-12).

10. As per Claim 7.

wherein said primary and said at least one secondary users accessing said network are assigned a unique personal workspace for providing said primary and said at least one secondary users with access to features of said network designated for said primary and said at least one secondary users (e.g. private / public, lounge, etc) (at least col. 4 line 59 - col. 5 line 2).

11. As per Claim 8.

wherein a user is assigned a password enabling access to predefined sites within said server (at least col. 4, lines 59-65).

12. As per Claim 9.

wherein the processor includes providing the primary user with a workgroup activity application (e.g. helper app) (at least col. 4, lines 24-30).

13. As per Claim 10.

wherein said workgroup activity application is selected from the group comprising bulletin board, chat room, calendar, contact database, change control, event planner, group discussion, issue management, project collaboration, presentation library,

decision survey in a box, NGS proposal development and document management (at least col. 4, lines 6-30).

14. As per Claim 16.

wherein said transmitter is selected from the group comprising e-mail, a pop-up window (auto launching app), a telephone, and a facsimile (at least col. 3, lines 48-64).

15. As per Claim 17, Jiang discloses a method for providing a communication network, wherein Jiang discloses:

(i) providing a network-connected server having upload and download capabilities (at least Fig. 8);

(ii) receiving instructions uploaded from a first user and for creating a dedicated network site on said server, said dedicated network site having a unique name based on instructions received (setting up conference web site / virtual conf. hall) (at least col. 2, lines 19-28; col. 4, lines 6-19);

(iii) communicating the existence of said dedicated intranet site to a nominated second user (transmit IP address) (at least col. 2, lines 28-38);

(iv) downloading data from said dedicated network site to said first and second users (e.g. helper app) (at least col. 5, lines 46-53);

(vi) storing data to be shared by said users in the dedicated web-site (at least col. 5, lines 3-16; col. 6, lines 51-52).

16. As per Claim 19 and 20, Jiang discloses a computer configured to operate a groupware application program, wherein Jiang discloses:

- (i) a network for connecting to at least a primary and a secondary user (interconnected network) (at least col. 2, lines 19-33);
- (ii) a site builder for receiving instructions input from said primary user and for creating a dedicated site within the computer based on said instructions (setting up conference web site) (at least col. 2, lines 19-28);
- (iii) a mailer for looking up an address of said secondary user from an address database (IP addresses) (at least col. 3, lines 48-64);
- (iv) a communicator for communicating the existence of said dedicated site to said secondary user (transmit IP address) (at least col. 2, lines 28-38);
- (v) memory for storing information at said dedicated site at the request of the primary and the secondary user (at least col. 5, lines 3-16; col. 6, lines 51-52); and
- (vi) a processor for processing said stored information at the request of the primary and the secondary user (e.g. MIME type stream) (at least col. 5, lines 12-22).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jiang.

19. As per Claim 11.

said at least one secondary user is a client (at least col. 1, lines 44-50; Fig. 6).

Jiang does not explicitly disclose said primary user is an advisor. OFFICIAL NOTICE is taken that Jiang's conference chair could act as an advisor. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of having an advisor advise clients with Jiang's system as this is simply a form of use for the invention and any person can behave as an advisor in a question/answer situation.

20. Claims 12-13, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jiang in view of Sammon et al (hereinafter "Sammon", 6,563,914).

21. As per Claim 12.

Jiang does not explicitly disclose said bulletin board and document management includes recommended advice and research documents from said advisor. However, the use and advantages for using such a service is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Sammon (at least col. 7, lines 9-22). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of a bulletin board into the lounge of Jiang as this would allow previous discussions, for example, to be posted and reviewed for members currently waiting for other members to join as Jiang discloses (see col. 4 line 59 - col. 5 line 2).

22. As per Claim 13.

wherein said chat room includes an on-line chat between said advisor (chair) and said client (at least col. 1, lines 44-50).

23. As per Claim 15.

wherein said group discussion includes a discussion between said advisor (chair) and said client (at least col. 1, lines 44-50).

24. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jiang in view of Sammon and further in view of Pinard et al (hereinafter "Pinard", 5,940,834).

Jiang and Sammon do not explicitly disclose said calendar and event planner include a list of tasks to be done and a list of upcoming events. However, the use and advantages for using such a event planning is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Pinard (at least col. 8 line 66 - col. 9 line 19). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of a calendar to list upcoming dates and events and an event planner to include things to be done as Pinard discloses into Jiang and Sammon's system as this would allow the conferences to be planned ahead of time for specific conferences to be done, for example, every week on projects to be done.

Response to Arguments

25. Applicant's arguments filed 15 September 2003 have been fully considered but they are not persuasive.

26. Applicants argue, substantially, that Jiang does not disclose a collaborative workspace wherein there is a hierarchy of users communicating via a dedicated site.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993). The claims specify creating a dedicated site in response to some initiated action and transmitting information between the site and a primary user and the site and a secondary user.

Jiang clearly discloses a user creating a dedicated site. Figure 7 discloses the dedicated website that is created defining the workspace to enable other participants to join into. Jiang discloses a primary user creating the site in Figure 5. A user is designated as being the 'chairperson' of the conference, while other users are designated as being participants and thus a hierarchy of users is created on the host (at least col. 3, lines 44-47; Fig. 4).

It appears applicant interprets the Jiang reference as not being a collaborative system, in that it is a peer-to-peer system of only one participant communicating with only one other participant. However, this clearly is not what Jiang is disclosing. Jiang discloses the client obtaining the IP addresses of the other participants so as all communication will be transmitted directly to each of multiple participants, and similarly received directly from each of multiple participants (at least Fig. 1, 2; col. 2, lines 14-38).

Jiang discloses the data to create or join a conference as being stored on the designated web site, and thus for a participant to initiate a connection to the conference, all communication as going through the central host (at least col. 5, lines 12-32). The timing of when the participants communicate with the central host is not disclosed in the claims. In fact, Jiang clearly discloses while in a conference, data may be transmitted to the host to change the conference chairperson or also to remove a participant from a

conference and thus changing the conference record on the host during the conference (at least col. 3, lines 44-61).

27. In response to applicant's argument that it would not be obvious for Jiang to disclose the primary user as being an advisor; see argument above with regards to Jiang not being a peer-to-peer system. Applicant's argument is not persuasive, the chairperson of the conference creates the conference pertaining to certain subject matter, eg. space exploration discussion or board meeting (at least Fig. 6). It is very well known in the art that a conference is to be held to discuss ideas and meet with others participants in order to come to a conclusion via advising other participants of each other's point of views. Further, Joseph et al is cited as having the provider of a chat service advising subscribers to the chat service (at least col. 3, lines 36-49).

Conclusion

28. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Newly cited Joseph et al and Tafoya et al as well as originally cited Ahuja et al (storing conferences), Harple et al (conference invitations), Gennaro et al (providing webpage to viewers), Smith et al (notifying recipient of document), Henderson et al (alerting recipient of document), D'Arlach et al (creating web-sites), Tarumi (groupware developing), and Yoshizawa (basic groupware systematics) are cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory G Todd whose telephone number is (703)305-5343. The examiner can normally be reached on Monday - Friday 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703)308-7562. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

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Art Unit: 2157


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Gregory Todd



Patent Examiner

Technology Center 2100



ARIO ETIENNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100